

Appl. No. 10/691,170
Amdt. dated July 16, 2007
Reply to Office action of March 16, 2007

REMARKS

This Amendment is in response to the Office Action mailed March 16, 2007. Claims 9-22, 26, and 28-31 have been cancelled without prejudice. Claims 1, 4-5, 23, 27 and 32 have been amended. Claims 33-34 have been added. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1-2 and 7 were rejected under 35 U.S.C. §102(e) as being anticipated by Pinder (U.S. Patent No. 6,424,717). Applicant respectfully traverses the rejection because a *prima facie* case of anticipation has not been established.

As the Examiner is aware, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

Herein, Applicant respectfully submits the Pinder does not teach a first process block to decrypt a message using the unique key to produce a key, where the key is formed using a mating key generator. The mating key generator comprises an identifier of a supplier of the scrambled digital content, the supplier being one of a cable provider, a satellite-based provider, a terrestrial-based provider, and an Internet service provider. Rather, the key (MSK 208 of Pinder) is generated by the Multi-Session Key generator (205), which appears to merely be a pseudo-random number generator and is not a message with an identifier of the supplier as claimed.

Moreover, with respect to claims 2 and 7, Applicant respectfully submits that a *prima facie* case of anticipation has not been established for these claims. However, since claims 2 and 7 are dependent on claim 1, believed by Applicant to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicant reserves the right to present

Appl. No. 10/691,170
Amdt. dated July 16, 2007
Reply to Office action of March 16, 2007

such arguments in an Appeal is warranted. Withdrawal of the §102(e) rejection as applied to claims 1-2 and 7 is respectfully requested.

Rejection Under 35 U.S.C. § 103

1. Claims 3 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pinder in view of Zhang (U.S. Patent No. 6,550,008). Applicant respectfully traverses the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988)*. Herein, the combined teachings of the cited references fail to describe or suggest all of the claim limitations.

For instance, the Office Action recites that Pinder does not disclose the descrambler IC with the second process being a finite state machine. *See page 5 of the Office Action*. We agree, but disagree with the allegation that Zhang discloses the descrambler IC with the second process being a finite state machine. Column 5, lines 55-60 of Zhang does not provide teaching that the second process block is a finite state machine. Rather, this section describes a controller (130) that is placed at the head-end system (14). Clearly, the head-end system (14) does not perform the descrambling functionality.

Moreover, with respect to claim 32, Applicant respectfully submits that neither Pinder nor Zhang, alone or in combination, describes or suggests a first process block that is controlled by a non-CPU based state machine to decrypt a message, namely a mating key generator, using the unique key to produce a key. The mating key generator is a message that comprises an identifier of one or more of (i) a manufacturer of a digital device employed with the descrambler IC, (ii) a service provider identifier, and (iii) a conditional access (CA) provider identifier.

Appl. No. 10/691,170
Amdt. dated July 16, 2007
Reply to Office action of March 16, 2007

In light of the foregoing, Applicant respectfully requests that the Examiner withdraw the rejection of claims 3 and 32 under 35 U.S.C. §103(a).

2. Claims 4-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pinder in view of Ferraro (U.S. Patent No. 5,151,782). Applicant respectfully traverses the rejection because a *prima facie* case of obviousness cannot be established for these claims. However, since claims 4-6 are dependent on claim 1, believed by Applicant to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicant reserves the right to present such arguments in an Appeal is warranted. Withdrawal of the §103(a) rejection as applied to claims 4-6 is respectfully requested.

3. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Pinder and in view of Alve (U.S. Patent No. 6,959,090). Applicant respectfully traverses the rejection, but since claim 8 is dependent on claim 1, believed by Applicant to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicant reserves the right to present such arguments in an Appeal is warranted. Withdrawal of the §103(a) rejection as applied to claim 8 is respectfully requested.

4. Claim 23-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pinder in view of Alve and Kocher (U.S. Patent No. 6,640,305). Applicant disagrees. With respect to independent claim 23, Applicant respectfully submits that neither Pinder, Alve nor Kocher, alone or in any combination, describes or suggests a first process block to encrypt a message using a unique, one-time programmable key to produce a first key. The message includes a mating key generator that comprises an identifier of at least one of (i) a manufacturer of a digital device employed with the descrambler IC, (ii) a service provider identifier, and (iii) a conditional access (CA) provider identifier. Rather, the Examiner relies on MSK, apparently a pseudo-random number with a lifetime of hours to days, to produce the first key that is used to recover a key for descrambling the scrambled digital content.

With respect to claims 24-25, Applicant respectfully traverses the rejection because a *prima facie* case of obviousness cannot be established for these claims. However, since claims

Appl. No. 10/691,170
Amdt. dated July 16, 2007
Reply to Office action of March 16, 2007

24 and 25 are dependent on claim 23, believed by Applicant to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicant reserves the right to present such arguments in an Appeal is warranted. Withdrawal of the §103(a) rejection as applied to claims 24-25 is respectfully requested.

5. Claims 26 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pinder and in view of Alve, Kocher and Ferraro. Claim 26 has been cancelled without prejudice. Withdrawal of this outstanding §103(a) rejection is respectfully requested. However, with respect to claim 27, this claim is dependent on claim 23, believed by Applicant to be in condition for allowance, so no further discussion as to the grounds for traverse is warranted. Applicant reserves the right to present such arguments in an Appeal is warranted. Withdrawal of the §103(a) rejection as applied to pending claim 27 is respectfully requested.

Telephone Conference

Based on the foregoing and in light of the amendments to the claims, Applicant respectfully requests that the Examiner reconsider the allowability of all of the pending claims. The Examiner is respectfully requested to contact the undersigned attorney at the phone number listed below if after reconsideration, such claims are still not in condition for allowance. This telephone conference would greatly facilitate the examination of the present application. The Examiner is thanked for his review and reconsideration of the allowability of the claims.

Appl. No. 10/691,170
Amdt. dated July 16, 2007
Reply to Office action of March 16, 2007

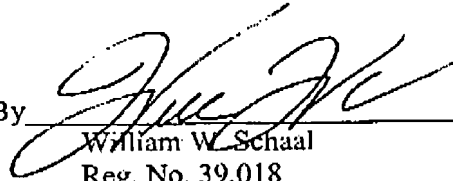
Conclusion

Applicant reserves all rights with respect to the applicability of the doctrine of equivalents. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: July 16, 2007

By



William W. Schaal

Reg. No. 39,018

Tel.: (714) 557-3800 (Pacific Coast)